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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,649	01/14/2004	Stuart Wilson	CDM/0662.9999	1627

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EXAMINER

ROBERTSON, TIARA S

ART UNIT PAPER NUMBER

3635

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/761,649

Applicant(s)

WILSON, STUART

Examiner

Tiara S. Robertson

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Swanson (3,531,903).

Regarding claims 1-2, and 7, Swanson discloses a steel, planar web comprising a top edge, a bottom edge, a length and a thickness (12 on fig. 1); the web defining a plurality of holes proximate its top edge and a plurality of holes proximate its bottom edge (See fig. 4); at least two rectangular top flange plates and two rectangular bottom flange plates which are separated from said web, one of said top flanges being located on each side of said web adjacent said top edge (14 and 16 on fig. 1); the top and bottom flange pieces defining a plurality of holes which are aligned with the holes in the web approximate the top edge (52 on fig. 1); a plurality of fasteners which extend through the holes in the top and bottom flange pieces and the holes in the web proximate the top edge and secure the top flange pieces to the web (46' on fig. 1).

Regarding claim 6, the applicant discloses flange pieces made of dimension lumber. Any lumber having a specified size is considered dimension lumber. In order for a construction beam to be effective, both the flanges and web member would have to be of a specified size. Therefore it would have been obvious for the lumber used to construct the flanges to be made of dimension lumber.

Regarding claim 8, Swanson discloses a beam as described in claim 1, where both of the top and bottom flange plates are on each side of the web.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson in view of the applicant's admission of prior art.

Regarding claims 3 and 4, the applicant claims dimensions for the web. The dimensions claimed appear to be a design choice developed by basic engineering practices and not a critical aspect of the claimed invention. Therefore it would have been obvious to one skilled in the art to size the beam at a width of  $1/8 - 1/2$  inch and a height of 1-4 feet.

Regarding claim 5, Swanson discloses a beam as described in claim 1 where the top and bottom flange pieces are made of wood. Swanson does not specifically

disclose that the flange members are made of strand lumber. The applicant admits that is well known in the art to construct beams of steel or strand lumber. Therefore it would have been obvious to one skilled in the art to modify the wood flanges disclosed by Swanson to include strand lumber. One would have been motivated to make such a modification to construct an I-beam with flanges made of a stronger engineered material.

5. Claims 1 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meem (1,759,057) in view of Conn (5,848,512).

Regarding claims 1 and 9-10, Meem discloses a beam as comprising a planar web comprising a top edge, a bottom edge, a length and a thickness (16 on fig. 4); the web defining a plurality of holes proximate its top edge and a plurality of holes proximate its bottom edge (See fig. 1); at least two rectangular top flange plates and two rectangular bottom flange plates which are separated from said web, one of said top flanges being located on each side of said web adjacent said top edge (15 on fig. 4); the top and bottom flange pieces defining a plurality of holes which are aligned with the holes in the web approximate the top edge and a plurality of fasteners which extend through the holes in the top and bottom flange pieces and the holes in the web proximate the top edge and secure the top flange pieces to the web (18). Meem does not disclose that the holes have counterbores where the heads and nuts of the fastening bolts fit. Conn discloses a beam member having counter sunken holes, which allow for the bolts to be flush with surface (30 on fig. 1). It would have been obvious to one skilled in the

art to modify the holes for receiving the fastening bolts, as shown by Haughian, to include the counter sunken holes, as shown by Conn. One would have been motivated to make such a modification so that the bolts would be flushed with the outer surface for aesthetic purposes and to allow for the fastener to become an integral component of the structural member.

Regarding claim 11, Meem discloses an I-beam as described in claim 1 but does not disclose a web member having a hole positioned between the top and bottom flange pieces. Conn discloses a web member having an aperture positioned between top and bottom flange pieces (20 on fig. 1). It would have been obvious to one having ordinary skill in the art to modify the web member of Meem to include an aperture as shown by Conn. One would have been motivated to make such a modification to allow for non-structural elements, such as pipe and wires, to pass through the web member of the I-beam.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tiara S. Robertson whose telephone number is 571-272-2944. The examiner can normally be reached on Monday-Thursday, 7-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/27/06

  
N. Slack  
Primary Ex.